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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,238	03/24/2004	Nobutaka Okuyama	501.43515X00	4523
20457 7590 07/20/2009 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873				
EXAMINER				
ALAM, MUSHFIK H				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/807,238

**Applicant(s)**

OKUYAMA ET AL.

**Examiner**

MUSHFIKH ALAM

**Art Unit**

2426

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6, 17, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 17 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 6, 17, 22-23 are pending.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/11/2009 has been entered.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 17, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krapf (US 6483986) in view of Karaoguz et al. (US 2004/0117836), and further in view of Goode et al. (US 6166730).

Claim 6, Krapf teaches a transmission and reception apparatus which can link with an external device via a network, comprising:

- a reception device (24) configured to receive a channel signal from broadcasted programs based on channel information (user requested channel) related to channel signal (col. 3, lines 30-41);
- a recording device (2) selectable to effect recording of the channel signal received by the reception device (fig. 2; col. 3, lines 47-57);
- an output device configured to output the video channel received by the reception device (col. 3, line 65-col. 4, line 3); and
- an input unit responsive to user manipulation (pause or request to view alternative subject matter data) (col. 4, lines 15-26),
- wherein, based on user manipulation (request for alternative subject matter data) from the input unit, the recording device starts recording of the channel and the output device stops outputting the channel signal (first content, 12) (col. 4, lines 15-46); and
- the recording device stops recording the video signal (i.e. when program is finished recording or when the watching point coincides with the recording point (col. 5, lines 8-16).

Krapf is silent regarding a transmission and reception apparatus which operates to receive a video signal and transmit it to an external device, comprising:

- a transmission system selectable to effect transmission of both said channel signal recorded by the recording device to the external device and said channel information related to said channel signals to the external device;
- wherein, in response to a request from the external device, the transmission system transmits, both the channel signal and channel information and the recording device stops recording the channel signal.
- wherein the transmission of said channel information is timing for starting of recording of said recording of said channel signal regarding to said channel information at the external device.

Karaoguz teaches a transmission and reception apparatus which operates to receive a video signal and transmit it to an external device, comprising:

- a transmission system (communication network) selectable to effect transmission (push to other devices) of the channel signal recorded by the recording device to the external device (fig. 1a; paragraph [0096]);
- wherein, in response to a request from the external device (requested by users), the transmission system transmits, both the channel signal (digital media) and channel information (bookmarks of Krapf, col. 5, lines 35-42) and the recording device stops recording the channel signal (paragraphs [0094], [0096], [0108]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a technique for transferring recordings across a network as taught by Karaoguz to the recordings as recorded in Krapf because it is desirable to be able to distribute many types of digital media in a user-friendly manner.

Goode teaches a transmission and reception apparatus which operates to receive a video signal and transmit it to an external device, comprising:

- transmitting said channel information (bookmarks information) related to said channel signals to the external device (col. 19, lines 1-43);
- channel information (col. 14, lines 38-54) of the video signal for enabling recording of a further recorded portion (saved movies) of the video signal which is broadcasted after receiving the request (bookmark) (col. 19, lines 1-43);
- wherein the transmission of said channel information (bookmarks) is timing (i.e. bookmarks are used for keeping the time position of the video stream for continuation) for starting of recording of said recording of said channel signal regarding to said channel information at the external device (i.e.

when resumed at external device) (col. 19, lines 1-43). *The bookmarks are interpreted as timing information due to the fact that they are used as a time position marker in the video stream.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a technique for transmitting bookmarks to receivers on a network as taught by Goode to the recorded portions of media of Krapf and Karaoguz in order to allow users to leave one terminal in the middle of a program and continue watching it from where they left off at a different terminal (col. 19, lines 1-43).

Claim 17, Karaoguz teaches the transmission and reception apparatus wherein the request from the external device is a request to time shift watch (previously recorded program) the video signal recorded by the recording device at the external device (paragraphs [0094], [0096]).

Claim 22, note the discussion of claim 6 above. Karaoguz teaches the external device including:

- a request unit to send the request (user requests) to the transmission and reception apparatus (paragraph [0096]);
- a second reception device configured to receive channel signal (recorded portions pushed to particular devices) from the broadcasted programs (one unit to the other) on said channel information regarding to said channel signal received by the reception device (paragraphs [0096], [0103], [0108]);

Goode teaches

the external device including:

- a second recording device (second set top terminal) configured to record the channel signal received by the second reception device (col. 19, lines 1-43); and
- a second output device configured to output said channel signal received by the reception system and then said channel signal recorded by the second recording device (col. 19, lines 1-43).
- after receiving said channel information (bookmarks) from the transmission and reception apparatus (other devices), the second recording device starts recording of said channel signal received by the second reception device (col. 19, lines 1-43);
- wherein, after starting recording of said channel signal, the second output device starts outputting (signals of Krapf and Karaoguz) of both said channel signals (col. 19, lines 1-43).

Claim 23, Goode teaches the transmission and reception apparatus wherein the request from the external device is a request to time shift (continue watching from a previous position) watch the video signal recorded by the recording device, at the external device (col. 19, lines 1-43).

### ***Response to Arguments***

5. Applicant's arguments filed 5/11/2009 have been fully considered but they are not persuasive.

The Examiner acknowledges the Applicant's request for an interview. However, due to time constraints an interview was unable to be held. The Applicant is welcomed to an interview after non-final, some remarks regarding amendments to more clearly define the invention are listed below.

The Applicant is advised to further clarify the "request" as claimed. Also, the feature regarding when a request is made from the external device and the act of stopping the recording and continuing the recording on the subsequent devices should be further clarified in the claims.

Claims 6, 17, 22, Applicant argues that Karaoguz teaches that communication network transmits only the video signal recorded by the recording device to the external device and Goode teaches only bookmark like the channel information. However, these references (taken individually, or in combination) do not disclose transmission of both said channel signal and said channel information. And Office Action comments do not point out them.

Applicant further argues that the bookmark taught by Goode is actually position within a video stream. (col. 14 and 19), not channel information. More particularly, while Goode does mention "channel" at a number of locations throughout the Goode disclosure, nowhere is Goode's bookmark associated with the channel. That is, Goode's bookmark is just video stream position information.

The Examiner respectfully disagrees. Reading the claims in the broadest sense, both references Karaoguz and Goode teach the ability to transmit video information from into location to another. Goode teaches bookmarks at admitted my Applicant, this is interpreted as channel information. Any information regarding the channel (i.e. program broadcasted on the channel) may be broadly interpreted as channel information. Thus, the bookmarks which serve as place holders for the position in the



video stream is still channel information that is to be transmitted to another device as utilized in a fashion similar the Applicant's invention.

### ***Conclusion***

6. Claims 6, 17, 22-23 are rejected.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUSHFIKH ALAM whose telephone number is (571)270-1710. The examiner can normally be reached on Mon-Fri: 8:30-18:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hirl Joseph can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7/16/2009

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July 16, 2009